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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,136	07/27/2001	Sherwin Shang	DI-5596A	3282
29200	7590	08/22/2006	EXAMINER	
BAXTER HEALTHCARE CORPORATION			MULLIS, JEFFREY C	
1 BAXTER PARKWAY			ART UNIT	
DF2-2E			PAPER NUMBER	
DEERFIELD, IL 60015			1711	

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,136

Applicant(s)

SHANG ET AL.

Examiner

Jeffrey C. Mullis

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1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-19 and 145-161 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-19 and 145-161 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claims 16-19 and 145-161 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as filed does not disclose that the second component is "free of cross-linking" but merely discloses "essentially free" of crosslinking and gives no indication that all traces of crosslinking can be eliminated from the second component and this limitation is therefore new matter.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16-19 and 145-161 are rejected under 35 U.S.C. 102(e) as being anticipated or in the alternative obvious by Woo et al. (US 6,743,523)

The instant claim recite that the second component "free of crosslinking", a disclosure not supported by the parent and the effective filing date of the instant case is the actual filing date, 7-27-01. The term "free" in fact appears only twice in the parent case specification and in neither instance pertains to crosslinking. Additionally the

dependent claims recite use of 4-methylpentene-1 (at least claim 16) and 75% first component (at least claim 19), features not present in the parent case.

The applied reference has common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Woo et al. in the examples 2-10 at column 10, lines 46 et seq disclose a "monolayer" film crosslinked by electron beam radiation having applicants amounts of polypropylene (PP3505GE1) and polyethylenes such as Engage 8003 or Affinity PL-1880.

It is noted that applicants are claiming a monolayer film not a multilayer film and therefore the application and patent claims are not obvious variations. Applicants examples and patentees are identical and hence reasonably appear to share and characteristics.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis

exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

Applicant's arguments filed 6-12-06 have been fully considered but they are not persuasive. The filing date of the instant claims is 7-27-2001 since a single embodiment is not sufficient to support the full scope of the claims which recite various genres and ranges, On the other hand a single embodiment reading on a claim is sufficient to meet the requirements of anticipation.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis
M-F, 9-5 PM at telephone number 571 272 1075.

Jeffrey C. Mullis
J Mullis
Art Unit 1711

JCM

8-17-06

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16-19 and 145-161 are rejected under 35 U.S.C. 102(e) as being anticipated by Woo et al. (US 6,743,523)

The instant claim recite an upper limit of 95% of first component which is broadly an ethylene containing polymer and lower level of 5% second component, a disclosure not supported by the parent and the effective filing date of the instant case is the actual filing date, 7-27-01.

The applied reference has a common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Woo et al. in the examples 2-10 at column 10, lines 46 et seq disclose a "monolayer" film crosslinked by electron beam radiation having applicants amounts of polypropylene (PP3505GE1) and polyethylenes such as Engage 8003 or Affinity PL-1880.

It is noted that applicants are claiming a monolayer film not a multilayer film and therefore the application and patent claims are not obvious variations.

Braga, (US 6,204,330), previously cited of interest discloses a crosslinked polyolefin composition requiring numerous polyolefin components. Since applicants films comprise

solely a first component and second component (ie two components) the reference does not anticipate or render the claims obvious.

The terminal disclaimer filed on 12-12-06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US patent 6,969,483 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Applicant's arguments filed 12-12-05 have been fully considered but they are not persuasive. The term "essentially free" does not appear in the parent case and the effective filing date of the instant case is therefore that of the actual filing date, 7-12-01.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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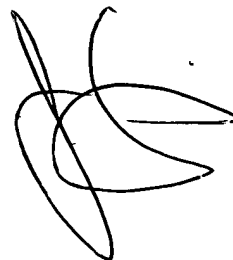
Any inquiry concerning this communication should be directed to Jeffrey C. Mullis
at telephone number 571 272 1075.

Jeffrey C. Mullis
J Mullis
Art Unit 1711

JCM

3-3-06

JEFFREY C. MULLIS
PRIMARY EXAMINER
GROUP 1288 1711

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a cursive 'C' and a final flourish.